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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/694,978	10/27/2003	Jacqueline C. Timans	DX0904KB1	4528

28008 7590 08/23/2005

DNAX RESEARCH, INC.  
LEGAL DEPARTMENT  
901 CALIFORNIA AVENUE  
PALO ALTO, CA 94304

EXAMINER

MERTZ, PREMA MARIA

ART UNIT	PAPER NUMBER
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1646

DATE MAILED: 08/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10/694,978	TIMANS, JACQUELINE C.	
	Examiner	Art Unit	
	Prema M. Mertz	1646	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 21-33 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group 1. Claims 21-27, are drawn to an antibody to a protein of amino acid sequence set forth in SEQ ID NO:2, classified in Class 424, subclass 139.1.

Group 2. Claims 21-27, are drawn to an antibody to a protein of amino acid sequence set forth in SEQ ID NO:4, classified in Class 424, subclass 139.1.

Group 3. Claims 28-30, are drawn to a method of modulating an inflammatory response in vitro with an agonist to SEQ ID NO:2, classified in Class 435, subclass 7.1.

Group 4. Claims 28-30, are drawn to a method of modulating an inflammatory response in vitro with an agonist to SEQ ID NO:4, classified in Class 435, subclass 7.1.

Group 5. Claims 28-30, are drawn to a method of modulating an inflammatory response in vitro with an antagonist to SEQ ID NO:2, classified in Class 435, subclass 7.1.

Group 6. Claims 28-30, are drawn to a method of modulating an inflammatory response in vitro with an antagonist to SEQ ID NO:4, classified in Class 435, subclass 7.1.

Group 7. Claims 31-33, are drawn to a method of modulating an inflammatory response in vivo by administering an agonist to SEQ ID NO:2, classified in Class 424, subclass 85.1.

Group 8. Claims 31-33, are drawn to a method of modulating an inflammatory response in vivo by administering an agonist to SEQ ID NO:4, classified in Class 424, subclass 85.1.

Group 9. Claims 31-33, are drawn to a method of modulating an inflammatory response in vivo by administering an antagonist to SEQ ID NO:2, classified in Class 424, subclass 139.1.

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Group 10. Claims 31-33, are drawn to a method of modulating an inflammatory response in vivo by administering an antagonist to SEQ ID NO:4, classified in Class 424, subclass 139.1.

Applicants are advised that claims 28-33 are improper Markush claims because the multiple elements recited therein, an agonist, and an antagonist, do not share a common technical feature which is based on a common property or special technical feature not found in the prior art. These elements, an agonist, and an antagonist, are independent and distinct chemical compounds lacking either a common structural property which distinguishes them as a group from structurally related compounds of the prior art or which provides them with a common utility which is lacking from prior art agonists and antagonists.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1-2, are independent and distinct, each from the other, because they are products which possess characteristic differences in structure and function and each has an independent utility, that is distinct for each invention. The antibodies of invention 1 can be used to obtain the polynucleotide encoding the protein of amino acid sequence set forth in SEQ ID NO:2, and can also be used in diagnostics, e.g. as a probe in immunoassays. This polynucleotide can only be used to produce the protein of SEQ ID NO:2, not the protein of SEQ ID NO:4.

Inventions 1 and 5, 9, are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P.

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§ 806.05(h)). In the instant case the product of invention 1 can also be used in immunochromatography.

Inventions 2 and 6, 10, are related as product and processes of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (M.P.E.P. § 806.05(h)). In the instant case the product of invention 2 can also be used in immunochromatography.

Inventions 1 and 3-4, 7-8 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 2 and 3-4, 7-8 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together, or they have different modes of operation, or they have different functions, or they have different effects. (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together.

Inventions 3-10 are independent and distinct, each from the other, because the methods are practiced with materially different process steps with materially different starting materials and each method requires a non-coextensive search because of different starting materials, process steps and goals.

Having shown that these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized

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divergent subject matter as defined by MPEP § 808.02, the Examiner has *prima facie* shown a serious burden of search (see MPEP § 803). Therefore, an initial requirement of restriction for examination purposes as indicated is proper.

Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 C.F.R. 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 C.F.R. § 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a diligently-filed petition under 37 C.F.R. § 1.48(b) and by the fee required under 37 C.F.R. § 1.17(h).

2. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully

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examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.**

Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

#### ***Advisory Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Premia Mertz whose telephone number is (571) 272-0876. The examiner can normally be reached on Monday-Friday from 7:00AM to 3:30PM (Eastern time).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (571) 272-0829.

Official papers filed by fax should be directed to (571) 273-8300. Faxed draft or informal communications with the examiner should be directed to (571) 273-0876.

Information regarding the status of an application may be obtained from the Patent application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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*Prema Mertz*

Prema Mertz Ph.D.

Primary Examiner

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August 15, 2005